

REMARKS

Claims 1-15, 18, and 20-23 remain in the application and are presented for reconsideration. Claims 16, 17 and 19 have been cancelled. Applicants thank the Examiner for withdrawal of all objections to the drawings and to the specification, and for withdrawal of the rejection of claims 9 and 20, under 35 USC 112, first paragraph.

REJECTION OF CLAIMS UNDER 35 USC 102(b)  
IN RESPECT OF U.S. DESIGN PATENT 264,246  
TO EKBLADH et al.

The Examiner has rejected claims 1-4, 6, 7, 9, 11-14, and 21, under 35 U.S.C. 102(b) as being anticipated by U.S. Design Patent No. D264, 246 to Ekbladh et al, herein Ekbladh. Applicants respectfully traverse this rejection for the following reasons.

The Examiner has stated that Ekbladh teaches all that is described in Applicants' claims 1-4, 6, 7, 9, 11-14, and 21. This includes the requirement that the handle of the presently claimed surgical instrument have at least one finger notch. In making this rejection, the Examiner calls attention to a depression of the surface in a figure attached by the Examiner. In the figure, the Examiner states that, "the at least one finger notch is a depression that receives a thumb and forefinger of a practitioner." The figure is taken from Ekbladh and annotated by the Examiner, with an indication of where a finger notch would be located. Applicants do not agree with the Examiner's conclusion.

The presently claimed surgical instrument has a handle (18) area having longitudinal fins (24), which is then altered into a finger notch (42) area. The finger notch is purposely designed to fit a finger during surgical use. This is clearly described in paragraphs [0030] and [0031] of the present application.

The finger notch area then changes into a narrow cross section in the suction tube area. In the instrument of the present claims, it is apparent that the finger notch (42) of the claims is an intentionally designed element of the instrument that facilitates manipulation of the instrument. The finger notch is provided intentionally as a place for a practitioner to place a finger or thumb such as the exemplified pair of diametrically opposed finger notches, described in paragraph

[0031] of the present application. This facilitates gripping of the instrument during rotation of the instrument.

In the present application, the finger notch is a purposely designed geometry that aids in the control and use of the suction device during surgery. In addition, a suction control vent (40) may be formed in the finger notch to adjust suction. Therefore, Applicants point out that the finger notch of the presently claimed instrument is a deliberately included element designed to fit the geometry of a finger.

By comparison, Applicants now turn to the device of Ekbladh that is said by the Examiner to have at least one finger notch that is a depression for receiving a thumb and forefinger of a practitioner.

The surgical aspiration catheter of Ekbladh neither discloses nor suggests a finger notch. In more detail, the design of the device of Ekbladh includes several different cross sectional areas. The device begins with a handle area that has fins or ribs, and which has a relatively large diameter. The size of the diameter is then reduced to allow the device of Ekbladh to be functionally usable. The reduction in size commences in a transition area of the device where the handle yet has fins or ribs. Thereafter, a further reduction of the diameter occurs in an area where there are no fins or ribs, and finally the device changes into the most narrow diameter in the suction tube area of the device.

From the design of Ekbladh, Applicants contend there is no intentionally designed or required finger notch, anywhere on the device, for a practitioner to place a finger or thumb. The area designated by the Examiner as a finger notch, in Ekbladh, and as being a depression for receiving a thumb and forefinger of a practitioner, is not an intentionally designed finger notch element. Indeed, the area so designated as a finger notch element by the Examiner, is nothing more than a transition area in the Ekbladh device where the diameter of a ribbed section begins to assume a required reduction in diameter.

In view of the above, Applicants contend that Ekbladh does not disclose a required finger notch of Applicants' claims, and, accordingly, does not disclose every element of Applicants' claimed invention. Therefore, Applicants respectfully request the Examiner to withdraw the

rejection of claims 1-4, 6, 7, 9, 11-14 and 21, as being anticipated, under 35 USC 102(b) by Ekbladh.

REJECTION OF CLAIMS UNDER 35 USC 102(b)  
IN RESPECT OF U.S. PATENT NO. 6,210,371  
TO SHAW

The Examiner has rejected claims 1, 5, and 18, under 35 USC 102(b) as being anticipated by U.S. Patent No. 6,210,371 to Shaw (herein Shaw). Applicants respectfully traverse this rejection for the following reasons.

The Examiner has stated that Shaw discloses all that is described in Applicants' claims 1, 5, and 18, including the handle having at least one finger notch. In respect to the finger notch, the Examiner has stated that the area labeled by no. 20, between fins no. 30 and no. 60, is interpreted as being a finger notch.

At the outset, Applicants incorporate herein all that was stated relating to Applicant's finger notch, in connection with the rejection based on Ekbladh, et al., under 35 USC 102(b).

With that in mind, Shaw neither discloses nor suggests the presence of a finger notch element in the winged I.V. apparatus of Shaw.

Shaw describes the wings (no. 30) which are used to stabilize the needle of the assembly as a result of being bendable and conformable to a patient's arm. Further, Shaw describes the projecting parts (no. 60) which are connected to the releasable latches to open or close the assembly. Also, the wall (no. 20) is connected to and extends along the axis away from the wings. This is the disclosure of Shaw. However, Applicants contend that none of the above may be considered disclosure or suggestion of the presence of a finger notch, in the device of Shaw.

Applicants do not dispute that the wall (no. 20) is an area where a finger can fit. The wall is a flat, open area that will allow engagement and/or disengagement of the latching mechanism of the device of Shaw. However, the wall (no. 20) was not intentionally designed to be a finger notch element, and Applicants contend that it is not reasonable to construe the wall (no. 20) as being equivalent to a finger notch element.

Applicants contend that wall (no. 20) of Shaw is different from, and does not correspond

to, a finger notch element that is designed to fit a finger, and which finger notch element facilitates manipulation of a surgical instrument and facilitates gripping of the instrument.

The feature of a finger notch is a requirement of all claims 1, 5, and 18, and, as such, all of claims 1, 5, and 18, are patentably distinct in respect of Shaw.

In view of the above, Applicants contend that Shaw does not disclose the required finger notch element of Applicants' claims 1, 5, and 8, and, accordingly, does not disclose every element of Applicants' claimed invention. Therefore, Applicants respectfully request the Examiner to withdraw the rejection of claims 1, 5, and 18, as being anticipated by Shaw, under 35 U.S.C. 102(b).

REJECTION OF CLAIMS UNDER 35 USC 102(b)  
IN RESPECT OF U.S. PATENT NO. 5,779,654  
TO FOLEY ET AL.

The Examiner has rejected claims 1 and 18, under 35 USC 102(b) as being anticipated by U.S. Patent No. 5,779,654 to Foley et al. (herein Foley). Applicants respectfully traverse this rejection for the following reasons.

The Examiner has stated that Foley discloses all that is described in Applicants' claims 1 and 18, including the handle having at least one finger notch element. In respect to the finger notch element, the Examiner has stated that the position between the longitudinal fins (no. 14) and the bend in the neck at the handle near the button (no. 24) is defined as being the finger notch element of Applicants' claimed invention.

At the outset, in respect of this rejection, Applicants hereby incorporate by reference all that was stated relating to Applicants' finger notch element, in connection with the rejection of claim 1 based on Ekbladh et al., under 35 USC 102(b).

Applicants contend that Foley neither discloses nor suggests the presence of a finger notch element in the clean breath wand device of Foley.

Foley describes a clean breath wand device wherein there is a curvature of the handle of the wand so that the face of the wand is in a particular relationship to the grip, where the longitudinal fins (14) are located. Button (24) is located near the bend in the neck of the handle.

It is the Examiner's conclusion that the position between the longitudinal fins (14) and the bend in the neck of the handle near button (24) defines the finger notch element of Applicants' claimed invention.

Applicants do not dispute that button (24) is located near the bend (or curve) in the neck of the handle of Foley's breath wand. It is Applicants' understanding that the position between the fins (14) and the button (24), is a curve or bend that is present in the wand of Foley to assure that the face of the wand is facing the surface where the wand is aimed.

Nor do Applicants dispute that there is a gap or position between the fins (14) and the bend in the neck of the handle near button (24). However, Applicants do not agree with the Examiner's statement that the gap or position between the fins (24) and the button (24) is a finger notch element, as required by Applicants' claimed invention.

The gap or position of Foley said by the Examiner to be a finger notch element required by Applicants, is not an intentionally designed finger notch where the practitioner can feel part of a geometry intended to receive a thumb and/or a forefinger. Applicants' finger notch element of the claimed surgical instrument is a specifically designed and intended element of the instrument, and is a required element of claims 1 and 18 of the present application.

Applicants contend that Foley does not disclose the required finger notch element of Applicants' claims 1 and 18, and, accordingly, does not disclose every element of Applicants' claimed invention. Therefore, Applicants respectfully request the Examiner to withdraw the rejection of claims 1 and 18, as being anticipated by Foley, under 35 U.S.C. 102(b).

#### REJECTION OF CLAIMS 5 AND 8 UNDER 35 USC 103(a)

The Examiner has rejected claims 5 and 8, under 35 USC 103(a) as being unpatentable over U.S. Design Patent No. 264,246 to Ekbladh et al. (herein Ekbladh). Applicants respectfully traverse this rejection for the following reason.

The Examiner has stated that Ekbladh discloses all that is claimed in claims 5 and 8 which are dependent on claim 1. Applicants do not agree with the Examiner's statement since Applicants contend that Ekbladh does not describe the presence of the required at least one finger notch element of the surgical instrument, for all the reasons described hereinabove.

Since claims 5 and 8 depend from claim 1, all of the limitations of claim 1 must be a necessary component of claims 5 and 8.

Applicants, therefore, respectfully request the Examiner to withdraw the rejection of claims 5 and 8, under 35 USC 103(a), as being unpatentable over Ekbladh.

#### REJECTION OF CLAIM 10 UNDER 35 USC 103(a)

The Examiner has rejected claim 10, under 35 USC 103(a) as being unpatentable over U.S. Design Patent No. 264, 246 (herein Ekbladh). Applicants respectfully traverse this rejection for the following reasons.

The Examiner has stated that Ekbladh teaches all of the invention of claim 10 except for grooves having different volumes. Claim 10 depends from claim 1, and accordingly, must include all the limitations of claim 1.

Applicants do not agree with the Examiner's statement regarding claim 10. Ekbladh does not teach the invention of claim 1 since the required presence of at least one finger notch element is not disclosed in Ekbladh, for all the reasons described hereinabove. Accordingly, claim 10 is patentably distinguishable.

Applicants, therefore, respectfully request the Examiner to withdraw the rejection of claim 10, under 35 USC 103(a), as being unpatentable over Ekbladh.

#### REJECTION OF CLAIM 15 UNDER 35 USC 103(a)

The Examiner has rejected claim 15, under 35 USC 103(a) as being unpatentable over U.S. Design Patent No. 264,246 (herein Ekbladh) in view of U.S. Patent No. 6,029,549 (herein Baker). Applicants respectfully traverse this rejection for the following reasons.

The Examiner has stated that Ekbladh teaches all of the limitations of claim 1, from which claim 15 depends, except for the content described in claim 15, which relates to wall thickness. According to the Examiner, Baker describes the feature of the wall thickness.

However, Applicants do not agree with the Examiner's statement that Ekbladh teaches all of the limitations of claim 1. As described above, Ekbladh does not disclose the presence in a surgical instrument of a finger notch element, that is a required feature of Applicants' claimed

invention. Therefore, claim 15 is patentably distinguishable.

Applicants, accordingly, request the Examiner to withdraw the rejection of claim 15, under 35 USC 103(a), as being unpatentable over Ekbladh in view of Baker.

#### REJECTION OF CLAIM 20 UNDER 35 USC 103(a)

The Examiner has rejected claim 20, under 35 USC 103(a), as being unpatentable over U.S. Design Patent 264,246 (herein Ekbladh) in view of U.S. Patent No. 6,210,317 B1 (herein Shaw) and U.S. Patent No. 6,029,549 (herein Baker). Applicants respectfully traverse this rejection for the following reasons.

The Examiner has stated that Ekbladh teaches all of the components of the medical suction apparatus of claim 20, including the finger notch element, except for the plurality of longitudinal fins and the plurality of longitudinal grooves described in claim 20. To overcome the deficiencies of Ekbladh, the Examiner has combined the teachings of Shaw relating to the plurality of longitudinal fins and Baker relating to the plurality of longitudinal grooves.

Applicants do not agree with the Examiner's statement regarding the teaching of Ekbladh. There has been extensive discussion hereinabove regarding the teaching of Ekbladh. Applicants contend, for the reasons herein, that Ekbladh does not disclose the presence of a finger notch element in the surgical catheter of the invention. As a result, the apparatus of claim 20 of Applicants' invention is patentably distinguishable.

Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of claim 20, under 35 USC 103(a), as being unpatentable over Ekbladh in view of Shaw and Baker.

#### REJECTION OF CLAIMS 22 AND 23 UNDER 35 USC 103(a)

The Examiner has rejected claims 22 and 23, under 35 USC 103(a) as being unpatentable over U.S. Design Patent No. 264,246 (herein Ekbladh) in view of U.S. Patent No. 6,086,587 (herein Hawk). Applicants respectfully traverse this rejection for the following reasons.

The Examiner has stated that Ekbladh discloses the invention of claim 1, from which claims 22 and 23 depend, except for the vent hole described in claims 22 and 23. To overcome this deficiency, the Examiner has combined the teaching of Hawk relating to a vent hole.

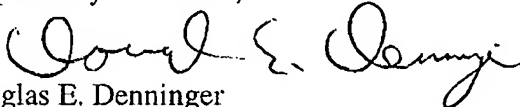
Applicants do not agree with the Examiner's statement that Ekbladh discloses the invention of claim 1. An in-depth discussion of Ekbladh appears hereinabove. As described therein, Ekbladh does not disclose a surgical catheter that includes at least one finger notch element. Accordingly, Applicants present claims 22 and 23 are patentably distinguishable.

Therefore, Applicants respectfully request the Examiner to withdraw the rejection of claims 22 and 23, under 35 USC 103(a), as being unpatentable over Ekbladh in view of Hawk.

#### CONCLUSION

Applicants believe the application is in condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the rejections of claims 1-15, 18, and 20-23. Applicants submit that claims 1-15, 18, and 20-23, are patentable, and respectfully request the Examiner to pass the application to issue.

Respectfully submitted,



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